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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,249

12/01/2003

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BAKER BOTTS L.L.P.

PATENT DEPARTMENT

98 SAN JACINTO BLVD., SUITE 1500

AUSTIN, TX 78701-4039

EXAMINER

PYO, MONICA M

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,249	<b>Applicant(s)</b> NECSOIU ET AL.	
	<b>Examiner</b> MONICA M. PYO	<b>Art Unit</b> 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-9,11-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-9,11-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***DETAILED ACTION***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/2/2008 has been entered.

2. Claims 1, 3-5, 7-9, 11-13, and 15-17 are currently pending in this application. Claims 1 and 15 are independent claims. In the Amendment filed 9/2/2008, claims 1, 11, 13, and 15 are amended, claims 2, 6, and 14 are canceled and claims 16 and 17 are newly added.

***Declaration under Rule 37 CFR. § 1.31 Affidavits***

3. The affidavit filed on 9/2/2008 under 37 CFR § 1.131 has been considered but is ineffective to overcome the Publication "Metadata and GIS; An ESRI White Paper", published on October 2002 ERIS (hereinafter ERIS) reference.

4. From MPEP § 715.04[R-5]:

The following parties may make an affidavit or declaration under 37 CFR 1.131:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

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(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate. .

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims.

5. In the interest of compact prosecution, the Examiner has considered the content of the declarations below:

*"In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." In re Asahi/America Inc., \*\*>68 F.3d 442, 37 USPQ2d 1204, 1206< (Fed. Cir. 1995) (Citing Newkirk v. \*>Lulejian<, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.)" (MPEP 715.07 III)*

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*"For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. King Instrument Corp. v. Otari Corp., 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985). For additional cases pertaining to the requirements necessary to establish actual reduction to practice see DSL Dynamic Sciences, Ltd. v. Union Switch & Signal, Inc., 928 F.2d 1122, 1126, 18 USPQ2d 1152, 1155 (Fed. Cir. 1991) ("events occurring after an alleged actual reduction to practice can call into question whether reduction to practice has in fact occurred"); Corona v. Dovan, 273 U.S. 692, 1928 C.D. 252 (1928) ("A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used. A manufacture [i.e., article of manufacture] is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed." 1928 C.D. at 262-263 (emphasis added).); Fitzgerald v. Arbib, 268 F.2d 763, 765-66, 122 USPQ 530, 531-32 (CCPA 1959) ("the reduction to practice of a three-dimensional design invention requires the production of an article embodying that design" in "other than a mere drawing")" (MPEP 2138.05).*

6. Exhibit A, submitted as a written and figure descriptions, **do not** constitute an actual reduction to practice and fail to establish that they reduced to practice working model. A written description, no matter how complete, **which has not been made the subject of a US patent application**, does not qualify as reduction to practice. See also *Coleman v. Dines*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party **must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception**. Conception

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must be proved by corroborating evidence.) Accordingly, Applicants have not established prior invention. The rejection is maintained.

***Requirements under Rule 37 CFR § 1.105***

7. The required documents were submitted on 9/2/2008. Therefore, the requirement made in a prior Office Action is fulfilled.

***Claim Objections***

8. Claim amendment received on 9/2/2008. The changes are acknowledged and accepted. Therefore, the claim objections made in a prior Office Action are withdrawn.

9. Claim 13 is objected to because of the following informalities:

Regarding Claim 13, this claims, in view of MPEP 1.121 (c), does not disclose the changes that have been made relative to the immediate prior version of the claims (3/6/2007). The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or few consecutive characters. In the instant case, claim 13 in the amendment filed on 9/2/2008 indicates the deletion of the limitation (i.e., [[XML]] ) which was not present in the earlier filed amendment and the addition of the limitations (i.e., HyperText Markup Language and ASCII metadata ) which was already present in the earlier filed amendment.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 3-5, 7-9, 11-13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Publication “Metadata and GIS; An ESRI White Paper”, written by ESRI, published on October 2002 (hereinafter ESRI), in view of U.S. Patent No. 6,879,988 issued to Basin et al. (hereinafter Basin), and further in view of U.S. Patent Publication No. 2003/00590919 by Brown et al. (hereinafter Brown).

Regarding Claims 1 and 15, ESRI disclose a method of providing access to geodata, the geodata having been acquired by an enterprise having an in-house data communications network, comprising the steps of:

**A). using a metadata builder to access geodata input files and to generate metadata files associated with the geodata files** (ESRI: pg. 1, [GIS Data Sharing on the Internet Is a Rality]; pg. 1, [ESRI Supports Metadata]);

**B). the geodata input files** (ESRI: pg. 1, [GIS Data Sharing on the Internet Is a Rality])

**C). storing metadata files in a repository serviced by the in-house data communications network** (ESRI: pg. 3, [How Does ESRI Support Metadata?]; pg. 6, [ArcSDE]);

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- D). wherein the repository stores a metadata file in XML format** (ESRI: pg. 2, [What Is Metadata?]; pg. 3, [How Does ESRI Support Metadata?]),
- E). using a metadata harvester to retrieve the metadata files from the repository and to build a metadata database** (ESRI: pg. 7, lns. 1-4; pg. 7, [Discovering Metadata With ArcCatalog]);
- F). wherein the metadata harvester retrieves each metadata file in XML (eXtensible Markup Language) format** (ESRI: pg. 7, lns. 1-4);
- G). wherein the metadata harvester comprises a file locator for retrieving XML files, a metadata compiler for compiling retrieved XML files, a converter for retrieving files and converting them to ANSI format, and a database builder for formatting the compiled and converted metadata files to relational database format** (ESRI: pg. 3, [Digital Communication Standards]; pg. 7, [Discovering Metadata]; pg. 8, [With Clearinghouse (Z39.50) Clients]);
- H). storing the metadata files in relational database format in a metadata database** (ESRI: pg. 3, [How Does ESRI Support Metadata?]);
- I). wherein the metadata database is accessible by an internet server** (ESRI: pg. 5, [Publishing Metadata]); and
- J). using the internet server to: communicate via the Internet with a user's web browser; to receive query data from the web browser; to respond to the queries by accessing the metadata database; a results page containing a list of records** (ESRI: pg. 7, [With ArcCatalog]), **each record having a metadata link to metadata associated with the**



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**record (ESRI: pg. 7, [With Metadata Explorer]); a metadata page from the repository in response to activation of the metadata link, the metadata page containing metadata and a image of the data associated with the metadata, and at least one link; to retrieve file from the repository in response to activation of the link; and to download locally the file via a web browser (ESRI: pg. 5, [Supported Data Types]; pg. 6, [ArcSDE]; pg. 6, [Clearinghouse Support]).**

Although ESRI does not specifically disclose the use of a file converter, Basin discloses the use of such a file converter to convert input files to downloadable archive files (Basin; col. 2, lns. 50-54; col. 4, lns. 48-52). It would have been obvious to one of ordinary skill in the art at the time of invention to utilize the teaching of Basin in the system of ESRI in view of the desire to enhance a quick and easy management and manipulation of input files.

ESRI does not disclose the feature of storing and retrieving a metadata file in HTML format. ESRI also does not disclose the feature of downloading a thumbnail image of the data in an archive file associated with the metadata. However, such features are known in the art as disclosed by Brown (pg. 4, [0049-0050], fig. 4; page 10, [0130-0131]) and the specific type of format utilized to store and access a metadata file would have been obvious to one of ordinary skill in the art in view of meeting different design requirements and achieving the particular desired performance.

ESRI in view of Basin and Brown do not explicitly disclose the feature of storing and accessing each metadata file in both XML and HTML format. However, such a feature is well known in the art that it would have been obvious to one of ordinary skill in the art to modify the system of ESRI in view of Basin and Brown to include the feature of storing and accessing a

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metadata file in a different format in view of the desire to provide a user the more flexibility of storing data.

Regarding Claim 3, ESRI and Basin and Brown disclose the method wherein one or more file formats and archive files are derived from a number of geodata input files (ESRI: pg. 1, [GIS Data Sharing on the Internet Is a Reality]) and (Basin: col. 4, lns. 48-54).

Regarding Claim 4, ESRI and Basin and Brown disclose the method wherein the archive files are lossless compressed data files (Basin: col. 4, lns. 48-54; col. 7, lns. 35-38).

Regarding Claim 5, ESRI and Basin and Brown disclose the method wherein the geodata input files may be any of the following formats: vector, raster, or tabular (ESRI: pg. 1, [GIS Data Sharing on the Internet Is a Reality]; pg. 7, [Discovering Metadata With ArcCatalog]).

Regarding Claims 7, 16 and 17, ESRI and Basin and Brown disclose the method wherein the database access is via a Z39.50 server (ESRI: pg. 3, [Digital Communication Standards]).

Regarding Claim 8, ESRI and Basin and Brown disclose the method wherein the metadata harvester retrieves metadata on a periodic basis (ESRI: pg. 7, [Discovering Metadata With ArcCatalog]).

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Regarding Claim 9, ESRI and Basin and Brown disclose the method wherein the metadata harvester retrieves only metadata files which are new since a prior harvest (ESRI: pg. 7, [Discovering Metadata With ArcCatalog]).

Regarding Claim 11, ESRI and Basin and Brown disclose the method wherein the metadata complies with the Federal Geographic Data Committee (FDGC) standard (ESRI: pg. 1, [GIS Data Sharing on the Internet Is Reality], [ESRI Supports Metadata]; pg. 5, [Standards-Based Metadata Tools]).

Regarding Claim 12, ESRI and Basin Brown disclose the method wherein the internet server may receive query data in any one of the following formats: spatial, keyword, or temporal (ESRI: pg. 3, [Digital Communication Standards]; pg. 6, [Clearinghouse Support]).

Regarding Claim 13, ESRI, Basin, and Brown disclose the method wherein each record has a first metadata link to an HyperText Markup Language (HTML) metadata file and a second metadata link to an ASCII metadata file (ESRI: pg. 3, [Digital Communication Standards]; pg. 8, [With Clearinghouse (Z39.50) Clients]; pg. 9, lns. 1-4) and (Brown: [0130], lns. 7-10).

***Response to Arguments***

12. Applicant's arguments filed 9/2/2008 have been fully considered but they are not persuasive.

Applicants submitted the declarations under 37 CFR 1.131 to swear behind the ESRI reference. However, the declarations are not sufficient to overcome the ESRI reference for the reasons above in the ***Declaration under Rule 37 CFR. § 1.31 Affidavits.***

In addition, applicant argues that ESRI does not disclose the feature of storing each metadata file in both XML and HTML format. The examiner does not refute the applicant's argument that ESRI does not specifically mention the feature of storing a metadata file in HTML format. However, the examiner does disagree with the indication that because of this difference the applicant's invention is patentable over prior art. Although ESRI does not specifically disclose the feature of storing a metadata file in HTML format, nothing in the ESRI reference explicitly excludes the possibility of storing a metadata file such a format. As stated above, the feature of storing a metadata file in a different format such as HTML format is known in the art as disclosed by Brown. The specific type of metadata formats utilized in a system would have been obvious to one of ordinary skill in the art in view of meeting different design requirements and achieving the particular desired performance and it would have been obvious to one of ordinary skill in the art to modify the system of ESRI in view of Brown to include the feature of storing and accessing a metadata file in a different format in view of the desire to provide a user the more flexibility of storing data.

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***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONICA M. PYO whose telephone number is (571)272-8192. The examiner can normally be reached on Tu & Thur 7:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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11/2008

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